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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217760
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of
Application Nos. 86/122,346; 86/122,347; 86/122,348; 86/122,349; and 86/122,350
For the Trademark OLD TAYLOR
Published April 15, 2014

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PERISTYLE, LLC)	
)	
Opposer,)	
)	
v.)	Opposition No.91217760
)	
SAZERAC NORTH AMERICA, INC.,)	
)	
Applicant)	
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**OPPOSER’S ANSWER TO APPLICANT’S MOTION TO DISMISS UNDER FRCP
12(b)(6)**

Applicant’s (Sazerac North American Inc.) motion to dismiss hinges on the allegations 1) that Opposer Peristyle, LLC (“Peristyle”) lacks standing to bring the opposition and 2) that Peristyle has failed to state a claim upon which relief can be granted. However, Peristyle has sufficient personal interest in the Mark (“OLD TAYLOR”) such that Peristyle has standing to bring the opposition. Furthermore, Peristyle has established sufficient facts showing that the Mark functions as a misdescriptive primary geographic descriptor, if Peristyle’s facts are taken as true. Furthermore, Applicant’s allegations of unconsidered facts do not meet the lofty standard required for dismissal of Peristyle’s claims. Therefore, Peristyle’s opposition must be considered to determine the weight of the facts at issue. Consequently, the Applicant’s motion to dismiss should be denied and the Opposition sustained.

I. SUMMARY OF ARGUMENT

The Opposition must be sustained, for two reasons: First, Peristyle has standing to bring the Opposition. Peristyle points out that an ownership interest in the Mark is not a requirement for standing. Rather, Peristyle has shown its direct and personal interest in the Mark due to the harm that would result if Peristyle were prevented from using “Old Taylor” at the historic Old Taylor distillery.

Second, the Opposition must be sustained, because the Applicant has not met the lofty standard required to support a motion to dismiss. Applicant is required to conclusively show that Peristyle cannot succeed on any contention, even with the facts construed in Peristyle’s favor. *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009). Rather, Applicant has merely argued its own belief that building names are not geographically descriptive without undermining Peristyle’s claims. Furthermore, Applicant’s argument that the primary significance of a Mark cannot be the Mark’s connection with a geographical location. However, the cases supporting Applicant’s argument are limited to coined descriptors. As such, Applicant has not shown that the Mark is a coined term and that OLD TAYLOR in connection with tourism has not become a generic descriptor used to refer to the historic Old Taylor distillery. Thus, taking Peristyle’s factual contentions as true, the Mark in connection with tourism is not a coined term, because the Mark has become primarily descriptive of the geographical location of the historic distillery. Therefore, Peristyle requests that Applicant’s Motion be denied in order to fully provide evidence of its contentions.

II. BACKGROUND

The Mark identifies the historic Old Taylor distillery located on McCracken Pike, Woodford County, Millville, Kentucky. In fact, Col. E.H. Taylor opened the historic distillery as

a Kentucky bourbon distillery in the 1880s. This historic distillery had been used for production of Old Taylor until the past 40 years. Furthermore, Col. E.H. Taylor regularly hosted visitors and tourists to connect the iconic castle-like structure of the main building with the Old Taylor Mark.

This history of the Old Taylor distillery and connection of the historic distillery and the Mark is important, because local and iconic distilleries have developed a chic among alcohol consumers. In fact, many craft brew beers become popular specifically due to the fact that they originate from a small and local producer.

However, this chic is not limited to craft brews of beer, but extends into the bourbon industry. Consumers have placed an increasing importance on the historical significance of the distillery itself. Thus, many of the top name distillers strive to retain the appearance of a historic and local distillery and to further develop a story in which their respective products have played some significant role in local history. In fact, Wild Turkey, Four Roses, Woodford Reserve, and many others provide tours of their historic distilleries as part of the development of the goodwill behind their mark. As such, some distilleries go so far as to lead consumers to believe that their production occurs mainly within the historic distillery when, in fact, most production occurs in a larger, offsite facility.

Applicant has retained the Mark for identification of the bourbon, but has abandoned use of the historic distillery for over forty years. However, the connection between the iconic castle distillery and the Mark remains. In fact, Peristyle recognized the significant historic value of the distillery in Kentucky's past. Therefore, Peristyle bought the historic distillery and wishes to share its history by hosting tours of the distillery in its historically accurate condition. The historic distillery contains many of the old signs bearing the Mark, which play a large part in historically accurate presentation of the distillery. However, Applicant now files multiple intent-

to-use applicants in connection with the following uses, herein referred to as “in connection with tourism”:

Applicant now files an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 15 for use with various printed educational materials in the field of whiskey, the history of whiskey, and for use in related tourism industries.

Applicant also files the Mark in International Class 35 for use with “promoting, marketing and fostering travel and tourism in the United States, namely, providing destination advertising services; marketing advertising and promoting goods and services of others in the field of American whiskey production, bottling, and distribution; online retail gift shops; promotional sponsorship of county and state fairs and community festivals and sporting, equestrian and athletic events; providing information via a website in the field of business information regarding whiskey distilleries; association services, namely, promoting the interests of the bourbon industry.”

Applicant files an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 39, in connection with “Providing travel and transportation information services via a global information network; organizing and operating travel tours related to the history of American whiskey and the production, bottling, and distribution of whiskey”.

Applicant files an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 40, in connection with “providing a destination web site for the provision of education information regarding whiskey distilleries”.

Applicant files an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 41, in connection with “educational services, namely, conducting classes and seminars in the field of whiskey; arranging and conducting special social events related to the whiskey industry for social entertainment purposes; providing private guided tours of museums, historical sites, and geographic points of interest; organizing social events, namely, whiskey tastings and food tastings; providing a destination web site for the provision of educational information regarding the history of American whiskey”.

Applicant’s continued use of the Mark in connection with the distribution and sale of bourbon does not erase the connection between the historic distillery and the Mark in connection with tourism. In fact, Applicant’s use of the Mark in connection with tourism would create the false reference to the historic Old Taylor distillery. Thus, Peristyle provides the following opposition against Applicants filings.

III. ARGUMENT

A. STANDARD OF REVIEW

Federal Rule of Civil Procedure 12(b)(6) and Section 503 of The Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) allow the Board to dismiss claims in an opposition proceeding “if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.” See Fed. R. Civ. P. Sec. 12(b)(6); TBMP Sec. 503.02. However, if the complaint at least “state[s] a claim to relief that is plausible on its face,” the complaint must not be dismissed. TBMP 503.02 (*citing Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)). Furthermore, “dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.” *Id.* Additionally, Peristyle does not have to

conclusively prove its allegations now, but has a right to obtain and submit evidence to be weighed at final hearing or upon summary judgment.” TBMP 503.02; *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Because the Board must accept all of Peristyle’s allegations as true and Applicant has not provided facts that conclusively undermine Peristyle’s case, Peristyle must be allowed to gather and submit evidence before the Board. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1205 (T.T.A.B. 1997).

**B. APPLICANT HAS FAILED TO MEET THE STANDARD FOR A
MOTION TO DISMISS BECAUSE PERISTYLE HAS STATED A
LEGALLY VALID CLAIM**

Peristyle has alleged in the notice of opposition facts which would, if proved, establish that Peristyle has (1) standing to challenge applicant’s right to register its mark and (2) set forth a statutory ground for denying the registration sought. *Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1029 (CCPA 1982). In support of these contentions, Applicant provides the following remarks.

**i. PERISTYLE HAS STANDING TO CHALLENGE THE
REGISTRATION OF APPLICANT’S OLD TAYLOR MARK**

Peristyle has pleaded facts sufficient to show its direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged. *Flame & Wax, Inc. v. Laguna Candles*, 2013 TTAB LEXIS 544, *8-9 (TTAB Oct. 2, 2013) (citing *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). Peristyle points out that it has purchased the historic Old Taylor distillery and uses and intends to use the phrase OLD TAYLOR in a fair use manner on various historic signs in connection with tourism.

Applicant believes that Peristyle’s lack of registration of the Mark or similar marks automatically removes any interest Peristyle could have in the Mark. Peristyle further points out

that the Federal Register is a notice publication system and not an exhaustive record of all instances of use or interest in every mark in the United States. In fact, many marks are used without registration. As previously explained, Peristyle uses the phrase not as a trademark, but a reference to the historic site as part of its tourism services. Because Applicant's registration of the Mark in connection with tourism could limit Peristyle's ability to use the phrase in a fair use manner in connection with tourism, Peristyle has sufficient interest in the Mark. Therefore Peristyle has standing to oppose the registration of Applicant's OLD TAYLOR mark.

ii. PERISTYLE HAS SET FORTH A VALID STATUTORY GROUND FOR OPPOSING REGISTRATION OF SAZERAC'S OLD TAYLOR TRADEMARK

In order to maintain an opposition, Peristyle does not yet need to conclusively prove its claim that the Mark is primarily geographically deceptively misdescriptive pursuant to section 2(e)(3) in order to bring this Opposition. Rather, Peristyle merely needs to point out the existence a contention, which will later be decided as part of the Opposition proceeding. *TBMP 503.02*. The standard for pointing out an existing contention is that, taking Peristyle's facts as true, Peristyle is entitled to the relief sought. *Id.* Furthermore, the Board may only dismiss the claims "if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim." *See F.R.C.P. 12(b)6; TBMP 503.02*. Thus, Peristyle must merely "state a claim to relief that is plausible on its face." *See TBMP503.02* (citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)).

In order to maintain the present Opposition, Peristyle merely needs to allege sufficient facts that, if proven, entitle Peristyle to the relief requested. Peristyle is entitled to relief by denial of the Application if 1) the primary significance of the Mark is a generally known geographic place; 2) purchasers would be likely to believe that the goods or services originate in the

geographic place identified by the Mark, when, in fact, they do not; and 3) the misrepresentation would be a material factor for a substantial portion of relevant consumers in deciding whether to buy the goods or use the services. *United States Playing Card Co. v. Harbro. LLC*, 81 USPQ2d 1537 (TTAB 2006).

The primary significance of the Mark is a generally known geographic place.

Peristyle has established an existing contention regarding whether the Mark is primarily geographically deceptively misdescriptive. The first open question of fact is whether the “primary significance of the mark is a generally known geographic place.” *Id.* Peristyle points out that the Mark is applied for in connection with tourism services. Furthermore, Peristyle urges that OLD TAYLOR used in connection with tourism services has been used to geographically identify the historic Old Taylor distillery, with the exception of the past forty years, since the 1880s. Due to the course of use of the Mark in connection with tourism services over this prolonged period, the Mark when referred to in connection with tourism has become an identifier of a geographic place, namely the historic Old Taylor distillery. Furthermore, due to consumers’ renewed interest in historic distillery culture and tourism, OLD TAYLOR refers to this one specific geographic place when used in connection with tourism. Thus, OLD TAYLOR is primarily an identifier for the historic distillery.

Applicant believes that Peristyle’s identification of the historic distillery by address is a conclusive admission that the Mark is not geographically descriptive. In stark contrast to Applicant’s allegation, the use of alternate geographic descriptors does not render the remaining geographic descriptors ineffective. Using a well-known example, referring to the White House by 1600 Pennsylvania Avenue does not erase the connection of the term “the White House” with the geographical location referred to. Peristyle contends that both the historical distillery can be

referred to by mailing address or by the geographically descriptive term Old Taylor Distillery. As pointed out above, consumers connect the Mark of the bourbon with the production distillery, and Applicant admit that the product, Old Taylor, was distilled at the abandoned distillery. (Applicant's Motion to Dismiss, September 28, 2015, pg. 6 and 7). Thus, Applicant's allegations against alternate geographic descriptors does not undermine the primary significance of the Mark.

Applicant then points to case law regarding its contention that coined locations are not geographic terms. However, Applicant has not proven that Old Taylor should be considered a coined term or that consideration of Old Taylor as a coined term excludes "Old Taylor" from being used primarily as a geographic descriptor when considering the Mark in connection with tourism rather than the Mark in connection with the product. In fact, "[t]he fact that the mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. Thus, if a geographic term has another meaning, the examining attorney must determine whether the primary significance is geographic." Notwithstanding the alternate use of "Old Taylor" as identifying bourbon and the geographic distillery, the examining attorney must determine whether the primary significance of "Old Taylor" is geographic. TMEP 1210.02(b)(i). Therefore, Applicant's argument does not undermine Peristyle's contention, with all Peristyle's facts taken as true. Thus, Peristyle respectfully requests that the opposition be sustained in order to fully present proof to establish its claims.

Purchasers would be likely to believe that the goods or services originate in the geographic place identified by the Mark, when, in fact, they do not.

Peristyle has previously pointed out the recent popularity of historic distillery tours. Thus, when OLD TAYLOR is used to describe tourism services, consumers would immediately

believe that the Mark referred to a tour of the historic Old Taylor distillery. In fact, Applicant would not be using the Mark in connection with tourism to describe the historic Old Taylor distillery. Thus, Purchasers would be likely to believe that the tourism services identified by the Mark originated in the historic Old Taylor distillery, when, in fact, it does not.

The misrepresentation would be a material factor for a substantial portion of relevant consumers in deciding whether to buy the goods or use the services.

As Peristyle points out above, consumers in the bourbon industry crave historic, local distillery tours due to the chic of local history. Therefore, the misrepresentation of OLD TAYLOR used to refer to tours of the non-historic facility would leave the false impression that the historic distillery was being referred to. Due to the chic of historic bourbon distillery tours, a substantial portion of customers would consider the history as the deciding factor when purchasing a tour of the distillery. Therefore, the misrepresentation of the connection between OLD TAYLOR and the historic distillery would be a material factor for a substantial portion of relevant consumers in deciding whether to go on the tour.

CONCLUSION

In light of the facts and arguments outlined above, Peristyle urges that 1) Peristyle has standing and 2) Peristyle states a claim to relief that is plausible on its face when Peristyle's facts are taken as true. Thus, Peristyle respectfully requests that Applicant's motion to dismiss be denied in order for Peristyle to present at opposition evidence regarding the primary geographic significance of "Old Taylor" in connection with tourism.

WHEREFORE, Opposer prays that the opposition be sustained and that registration to Applicant be refused.

Respectfully Submitted,

Date: October 29, 2015

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 29th day of October, 2015, a true and correct copy of the foregoing Notice of Opposition was served by regular U.S. mail upon the following counsel for Applicant:

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